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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/582,790

07/05/2000

FUJIO MORI

2000-0938A

13<sup>2735</sup>

7590

09/16/2003

WENDEROTH LIND & PONACK  
2033 K STREET NW  
SUITE 800  
WASHINGTON, DC 20006

EXAMINER

UHLIR, NIKOLAS J

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 09/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/582,790

Applicant(s)

MORI, FUJIO

Examiner

Nikolas J. Uhler

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 22-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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### **DETAILED ACTION**

1. This office action is in response to the amendment/arguments dated 7/17/03. The applicant's arguments with respect to the prior objection to the specification are considered persuasive. Accordingly, this objection is withdrawn. Applicant's amendment to claims 35 and 39-42 are considered sufficient to overcome the prior applied 112 2nd paragraph rejection. Accordingly, these rejections are withdrawn. Finally, applicant's arguments with respect to the prior applied U.S.C 103(a) rejections are not persuasive for the reasons set forth below in the section entitled "Response to Arguments." The prior 103(a) rejections are hereby maintained and made final.

#### ***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 22-28, 33-36, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al. (JP09300397).

4. This rejection is maintained as set forth in paper #11.

5. Claims 29-32 and 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al. as applied to claim 22 above, and further in view of Lau et al. (US2001/0020047).

6. This rejection is maintained as set forth in paper #11.

7. Claims 39-42 rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al. as applied to claims 1 and 43 above, further in view of Kitamura et al. (0475085).

8. This rejection is maintained as set forth in paper #11.

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***Response to Arguments***

9. Applicant's arguments filed 07/17/03 have been fully considered but they are not persuasive. In the instant case, the applicants primary argument against Mori is directed towards the fact that while the reference cited utilize materials that are of a similar type to those utilized by the instant invention, the fact that these materials are of a similar type (i.e. methyl methacrylate or ABS) does not establish that they will necessarily meet or exceed the applicants claimed property requirements, as there are many types of methyl methacrylate and ABS (acrylonitrile butadiene styrene) resins, many of which the applicant opines would not meet the applicants claim requirements.

10. This argument is not persuasive. The applicant is reminded that it has been held that where claimed and prior art products are identical or substantially **identical in structure or composition**, or are produced by identical or substantially identical processes, **a *prima facie* case of either anticipation or obviousness has been established and the burden of proof is shifted to applicant** to show that prior art products do not necessarily on inherently possess characteristics of claimed products where the rejection is based on inherency under 35 USC 102 or on *prima facie* obviousness under 35 USC 103, jointly or alternatively.

11. The examiner acknowledges that there are various types of polymers that would fall under the class of polymers known as methyl methacrylates or ABS resins, and that it is conceivable that some of these polymers may not meet the applicant's claimed property requirements. However, merely arguing that polymers of the same classification can be made to have different material properties does not conclusively

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show that the polymers specifically utilized by the prior art will not possess the claimed properties. Further, this argument is not persuasive because the examiner has not only shown that similar materials are utilized in the prior art (i.e. substantially identical composition), but also that the materials are arranged to form a product having a substantially identical structure to that claimed by the applicant. The structure formed by Mori et al. utilizes similar materials, with similar if not identical layer structure, wherein the layers are as thick if not thicker than those utilized by the instantly claimed invention, and the layers are in similar if not identical order. Thus, even if the applicant's arguments with respect to the composition of the prior art were persuasive, the applicant has not shown that the end product of Mori, which is substantially identical in structure and quite similar in material composition to that of the instantly claimed invention does not meet the applicant's claimed property requirements. Thus, applicant's arguments on this point are unpersuasive.

12. With respect to the combination of Lau with Mori, the applicant argues that Lau fails to teach or suggest that the radiation curable olefin material could be applied to film usage, and argues that it "may" be impossible to use such a material for film forming, as radiation curable olefins are not typically stretchable. The applicant argues that contrary to Lau, the olefin material utilized by the instant invention is an ethylene-propylene rubber, which "greatly differs from that of Lau with regard to various characteristics.

13. This argument is not persuasive. The mere assertion that radiation curable materials "may" not be able to be utilized as film forming materials cannot be considered persuasive, as if these materials "may" not be able to be used for film

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forming materials, they necessarily "may" be able to be utilized for this purpose. Further, merely arguing that the ethylene-propylene copolymer utilized by Lau is "substantially different" than that of the ethylene-propylene copolymer of Lau does not persuasively show the asserted differences. Lau teaches adding an ethylene-propylene copolymer which is radiation cross linkable to a polyolefin for the purpose of improving the surface characteristics of the polyolefin. The applicant should note that the prior art recognizes that "Ethylene propylene rubber (EPM)..... is an ethylene-propylene copolymer which can be cross-linked by radiation curing" (See US4607074 to Hazelton et al. column 5, lines 10-11 and 25-35). Thus, absent a definitive showing that the ethylene-propylene copolymer taught by Lau is substantially different from the "propylene containing olefin rubber" required by claim 30, this argument is unpersuasive.

14. Finally, the applicants argue that the material of Kitamura (JP '085) is different from that of the instantly claimed invention, because the material of Kitamura exhibits a rupture stretch of 200%, whereas the instant invention is hardly stretched and shrunk. The examiner acknowledges that JP '085 does indeed teach a backing material that ruptures when it is stretched over 200%. However, the applicant's argument is largely irrelevant with respect to this point, as the applicants claims do not require that the film not be stretched during production of the in mold decorating sheet. The applicant's claims require the back film to "exhibit a dimensional change within 0.6% at 90° C. No requirements as to force applied (i.e. during molding) to the film at 90° C are required. No requirement as to the stretching of the film during the formation of the in mold decorating sheet are required. The claim merely requires the material to have a specific

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dimensional change at 90<sup>0</sup> C, where aside from the temperature no outside forces are applied to the sheet. Thus, given that the material used for the carrier sheet is of the same type utilized by the applicant, this argument is not persuasive without a clear showing that the material utilized by the prior art (without any outside force aside from the 90<sup>0</sup> temperature) does not meet this limitation. The mere argument that the prior art does not meet a limitation is not persuasive.

### ***Conclusion***

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikolas J. Uhlir whose telephone number is 703-305-0179. The examiner can normally be reached on Mon-Fri 7:30 am - 5 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on 703-308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-0389.

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*Paul Thibodeau*  
Paul Thibodeau  
Supervisory Patent Examiner  
Technology Center 1700